

### **REMARKS**

This responds to the Office Action mailed on March 18, 2004, which rejects all of the pending claims (i.e., claims 1-43). Reconsideration in view of the following remarks is respectfully requested.

### **OFFICE ACTION RESPONSE TO APPLICANT'S ARGUMENTS**

#### **Evidence of Teaching Away and Unsuitability for Intended Purpose**

Paragraphs 4-6 of the Office Action states:

4. The applicant . . . argues that the combination of DeSimone et al. (USPN 5,787,470) and Armbruster et al. (USPN 6,243,760) is improper because "the proposed modification cannot render the prior art unsatisfactory for its intended purpose" (page 4, paragraph 2). The applicant goes on to state that "DeSimone emphasizes that the protocol by which caches update each other about what objects are in their cache is different from actually sending the objects . . . explicitly teaches away from distributing objects themselves . . . DeSimone clearly teaches away from distributing information as in Armbruster" (page 6, paragraph 2-3).

**The argument is not persuasive because the combination of the references renders the limitations of the current claims**

**obvious.** Further the teachings of DeSimone et al. (USPN 5,787,470) do not necessarily teach against the functions of Armbruster et al. (USPN 6,243,760). Specifically, if the information collected by DeSimone et al. (USPN 5,787,470) is made available in the cache framework of Armbruster et al. (USPN 6,243,760) then all of the limitations of the current claims are met. More clearly, the information collected by DeSimone et al. (USPN 5,787,470) would become the content distributed by Armbruster et al. (USPN 6,243,760). Thus the teachings of DeSimone et al. (USPN 5,787,470) do not teach away from the framework of Armbruster et al. (USPN 6,243,760).

5. The applicant further argues that the Examiner "flatly ignores an intended purpose of DeSimone" because DeSimone et al. (USPN 5,787,470) allows a cache to choose which content is preferred while Armbruster et al. (USPN 6,243,760) does not. This does not change the fact that the information of DeSimone et al. (USPN 5,787,470) in the framework of Armbruster et al.

(USPN 6,243,760) renders the current claims obvious. Whether or not all the information is sent or not sent does not affect the function of the framework of Armbruster et al. (USPN 6,243,760).

6. All further arguments are not persuasive for the same reasons shown above.

(Office Action, pages 3-4)(emphasis added)

Thus, the Office Action states that Applicant's evidence of "teaching away" and "unsuitability for intended purpose" is "**not persuasive because the combination of the references renders the limitations of the current claims obvious**". The Office Action further states that DeSimone does not necessarily teach against the function of Armbruster because if the information collected by DeSimone . . . is made available in the cache framework of Armbruster et al. . . . then all of the limitations of the current claims are met." In addition, the Office Action states that although the Applicant has presented evidence that the proposed combination would leave DeSimone unsuited for its intended purpose, "this does not change the fact that the information of DeSimone et al. . . . in the framework of Armbruster et al. . . . renders the current claims obvious".

In view thereof, Applicant respectfully submits that the Office Action has not weighed the evidence presented by the Applicant (e.g., "teaching away" and "unsuitability for intended purpose") against the evidence presented by the Examiner. Rather, the Office Action has boldly concluded that the claims are obvious and then used that conclusion to dismiss Applicant's evidence as not persuasive.

Accordingly, Applicant respectfully submits that the Office Action has failed to meet the requirements of MPEP 2142, which states that:

If the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered

in opposition to it. With the regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not.

When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

(MPEP 2142, Rev. 2, May 2004, page 2100-129)

In addition, the Office Action also fails to meet the requirements of MPEP 2144.08, which states that:

[a] determination under 35 U.S.C. 103 should rest on all the evidence and should not be influenced by any earlier conclusions. See e.g., *Piasecki*, 745 F.2d at 1472-73, 223 USPQ at 788; In re Eli Lilly & Co., 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Thus, once the applicant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record. See, e.g., *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788; *Eli Lilly*, 902 F.2d at 945, 14 USPQ2d at 1743. All the proposed rejections and their bases should be reviewed to confirm their correctness. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the Office's findings and conclusions, articulating how the conclusions are supported by the findings.

(MPEP 2144.08, Rev. 2, May 2004, page 2100-154, col. 1, line 25 - col. 2, line 25)

The Office Action also fails to meet the requirements of MPEP 2144.05, which states that a prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention (MPEP 2144.05, Rev. 2, May 2004, page 2100-143, col. 2, lines 15-17).

As further described below, DeSimone et al and Armbruster et al. each clearly teach away from the proposed combination.

For example, as further described below, DeSimone et al. teach a form of demand caching in which a cache retrieves an object requested by a user and caches the object for later access by other users (col. 1, lines 30-46). According to DeSimone, such caching reduces delay as perceived by the other users (col. 1, lines 40-46). However, DeSimone rejects the possibility of distributing objects (see detailed discussion of DeSimone below) in view of the two motivations for the invention, i.e., to save network and cache resources (col. 4, lines 53-62) and to allow the caches to choose what objects to receive and cache **before** they are downloaded (col. 4, lines 65-67).

Armbruster et al. explicitly teach away from demand caching in view of the problems it creates (col. 1, lines 26-55; col. 2, lines 3-4). Rather than demand caching, Armbruster employs a method of push caching (col. 2, line 50-51), wherein a content provider determines what files are to be cached (col. 4, lines 39-40) and where the files are to be cached (col. 5, lines 7-9). According to Armbruster, demand caching and its hierarchies make routing difficult and are complex to maintain and implement (col. 1, lines 50-52). In addition, demand caching often violates copyright laws (col. 1, lines 46-47). Moreover, with demand caching, clients determine what is cached by their access patterns (col. 1, lines 36-37). As a result, the content provider becomes a passive participant and is often unaware that its material is being copied and stored (col. 1, lines 43-46). This makes it difficult for content providers to control access to their sites and to get an accurate picture of how often their pages are being accessed (col. 1, lines 53-56). Still further, with demand caching, cached copies and originals are not synchronized, and as a result, the copy returned to other users is sometimes not the content providers most recent copy but rather the previously cached version.

Thus, DeSimone et al. and Armbruster et al. each clearly teach away from the combination proposed by the Office Action. That is, DeSimone et al. recognize and teach that caching reduces perceived delay for a user (DeSimone, col. 1, lines 40-47), yet DeSimone et al. explicitly teach away from the possibility of distributing objects to the caches (see detailed discussion of DeSimone below) in order to save network and cache resources (col. 4, lines 53-62) and to allow the caches to choose what objects to receive and cache **before** they are downloaded (col. 4, lines 65-67). One of ordinary skill in the art would not modify the system of DeSimone as proposed by the Office Action if that modification would leave DeSimone unsuited

for its intended purpose. Armbruster et al. teach away from demand caching altogether, in view of the problems it creates (Armbruster col.1, lines 26-55; col. 2, lines 3-4). Modifying DeSimone to distribute objects as proposed by the Office Action would only serve to magnify and exacerbate such problems. Thus, both DeSimone et al. and Armbruster et al. teach away from the combination proposed by the Office Action.

Thus, the Office Action fails to meet the requirements of MPEP 2145 which states that it is improper to combine references where the references teach away from their combination (MPEP 2145, Rev. 2, May 2004, page 2100-162, col. 1, lines 24-30, citing *In re Grasselli* 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

In the event that any of the rejections set forth in the Office Action is to be maintained, Applicant respectfully requests issuance of **a new non-final** Office Action that fulfills the requirements set forth above by demonstrating that the decision on patentability was made based upon consideration of all the evidence, including the evidence submitted by the Applicant, and that the evidence submitted by the Applicant was evaluated along with the facts on which the conclusion of obviousness was initially reached, not against the conclusion itself. The Office Action should also demonstrate that the ultimate determination of patentability is based on the entire record, by a **preponderance of evidence**, which requires the evidence to be more convincing than the evidence which is offered in opposition to it.

### **Hindsight Reasoning**

Paragraph 3 of the Office Action states:

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(Office Action, pages 2-3)

Applicant respectfully submits that weight of the evidence teaches away from the combination of DeSimone et al and Armbruster et al. The fact that the claims nonetheless stand rejected on the basis of such combination indicates that the rejections are based on hindsight reasoning.

Consequently, Applicant respectfully submits that the Office Action fails to meet the requirements of MPEP 2142, which states that:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person . . . . The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

(MPEP 2142, Rev. 2, May 2004, page 2100-128, col. 1, line 45-col. 2, line 17)

Applicant respectfully submits that in this instance, the Examiner has not stepped backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made, and made a determination, in view of all factual information, as to whether the claimed invention "as a whole" would have been obvious at that time to that person. Indeed, in this instance, it is only Applicant's application which suggests the desirability of the subject matter recited in the claims.

#### **Evidence in Support of Proposed Motivation to Combine**

In paragraph 2, the Office Action states that:

2. The applicant argues that the Examiner has not presented legally sufficient evidence to support the motivation . . . to combine the references' and the Examiner makes "a bold assertion without any evidence in support" (page 3, paragraph 2-3). The argument is not persuasive because **the Examiner has relied on information generally available to one of ordinary skill in the art to provide motivation. There is no requirement to show a reference for motivation in combining references.** However, the

reference to Armbruster et al. (USPN 6,243,760) clearly states that "One solution to the problem of ever increasing bandwidth requirements is to bring web content to locations close to users by means of a cache" (column 1, lines 19-21). This supports the geographical distribution of cache information such as that stored by DeSimone et al. (USPN 5,787,470). Further, the applicant points out in the background information section of the specification that "A second solution is to use so called caching techniques . . . at a location closer to the user than the original files (page 2, paragraph 3). The applicant concedes that it is well known that moving information close physically to a user provides a benefit to the system. This is adequate evidence for the motivation to combine the references.

(Office Action, page 2)

Applicant respectfully traverses the findings and assertions set forth in the Office Action.

The Office Action asserts that the Examiner has relied on information generally available to one of ordinary skill in the art to provide motivation. The Office Action further asserts that there is no requirement to show a reference for motivation in combining references.

Applicant respectfully traverses the assertion that evidence is not required to support the purported motivations set forth and relied upon by the Office Action in rejecting the claims. Such assertion fails to meet the requirements of MPEP 2144.03, which states that "it is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based (MPEP 2144.03, Rev. 2, May 2004, page 2100, col. 1, lines 13-17 citing Zurko, 258 F.3d at 1385, 59 USPQ2d at 1607 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-on on its assessment of what would be basic knowledge or common sense"))).

Applicant also traverses the assertion that a person having ordinary skill in the art would have readily been motivated to modifying DeSimone et al. (USPN 5,787,470) by employing the distribution of data to geographically separate cache servers.

Applicant also traverses the assertion that "[g]eographically distributing data allows for the least amount of physical distance between the end user and the cache thus benefiting the system by reducing retrieval time" was common knowledge. In that regard, Applicant points out that geographic proximity is not the same as network proximity. Indeed, allowing the least amount of physical distance between the end user and a cache may end up increasing the

network distance between the end user and a cache, thereby increasing the retrieval time. For example, the physical distance from Hong Kong to London (Heathro) is 6052 miles. The number of hops needed for a data packet to travel therebetween is 13, resulting in a round trip travel time of 343 msec. On the other hand, the physical distance from Hong Kong to Washington, D.C. is 8186 miles. Yet the number of hops needed for a data packet to travel therebetween is only 11, resulting in a round trip travel time of 244 msec. Thus the physical distance from Hong Kong to Washington, D.C. is greater than the physical distance from Hong Kong to Heathro. However, from a network perspective, the distance from Hong Kong to Washington, D.C. is less than the distance from Hong Kong to Heathro.

Applicant also traverses the assertion that the above cited statement from Armbruster et al. (i.e., "One solution to the problem of ever increasing bandwidth requirements is to bring web content to locations close to users by means of a cache" (column 1, lines 19-21)) supports the geographical distribution of cache information such as that stored by DeSimone et al. Rather, the context of the cited statement from Armbruster makes clear that the phrase "location closer" refers to a location that is closer in a network sense, which may or may not be closer in a geographic sense. In evidence thereof, Applicant notes that the context refers to the problems of bandwidth and congestion in the network and frustrating delays for the users (col. 1, lines 16-19).

Applicant also traverses the assertion that the above cited statement from Applicant's application (i.e., "A second solution is to use so called caching techniques . . . at a location closer to the user than the original files (page 2, paragraph 3)) concedes that it is well known that moving information close physically to a user provides a benefit to the system. Rather, the context of the cited statement from Applicant's application makes clear that the phrase "location closer" refers to a location that is closer in a network sense, which may or may not be closer in a geographic sense. In evidence thereof, Applicant notes that the context refers to avoiding the "transatlantic link", which is a network element and consequently, the location is closer in a network sense.

For at least the reasons above, Applicant respectfully submits that findings set forth in the Office Action are not supported by adequate evidence.

Accordingly, in the event that any of the rejections is to be maintained, Applicant respectfully requests that Office Action provide documentary evidence to support each finding proposed therein, so as to fulfill the requirements of MPEP 2144.03 (MPEP 2144.03, Rev. 2, May 2004, page 2100-138, col. 1, lines 17-30).



**REJECTIONS UNDER 35 U.S.C. §103****CLAIMS 1-13**

Paragraph 9 of the Office Action rejects claim 1 under 35 U.S.C. §103(a) as being unpatentable over DeSimone et al., U.S. Patent No. 5,787,470 (hereinafter DeSimone) in view of Armbruster et al., U.S. Patent No. 6,243,760 (hereinafter Armbruster). The Office Action states that

DeSimone et al. (USPN 5,787,470) teach a system for caching internet information to increase web performance with means for:

- a. Deriving information sent to an end user from an Internet content provider based upon an information request from the end user . . .

[however] it fails to disclose means for:

- a. Distributing the information to a set of geographically distributed cache servers.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by DeSimone et al. (USPN 5,787,470), as evidenced by Armbruster et al. (USPN 6,243,760). . . [which] discloses a system for improving web performance with means for:

- a. Distributing the information to a set of geographically distributed cache servers. . .

Given the teaching of Armbruster et al. (USPN 6,243,760), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying DeSimone et al. (USPN 5,787,470) by employing the distribution of data to geographically separate cache servers. Geographically distributing data allows for the least amount of physical distance between the end user and the cache thus benefiting the system by reducing retrieval time.

(Office Action, paragraph 9)

Applicant respectfully traverses the rejection of claim 1 on the grounds that the proposed combination of DeSimone and Armbruster is improper.

First, the Office Action has not presented **legally sufficient evidence** to support the motivation proposed by the Office Action to combine the references. The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness, including suggestion or motivation to combine the references (MPEP 2142). In order to try to satisfy this burden, the Office Action states that:

a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying DeSimone et al. (USPN 5,787,470) by employing the distribution of data to geographically separate cache servers. Geographically distributing data allows for the least amount of physical distance between the end user and the cache thus benefiting the system by reducing retrieval time”.

(Office Action page 4, lines 10-14)

However, this is merely a bold assertion, without **legally sufficient evidence** in support thereof. That is, the Office Action does not identify legally sufficient evidence to support the assertion that modifying DeSimone as proposed would provide a benefit in the system of DeSimone or that one having ordinary skill in the art would have readily recognized such a benefit.

Without legally sufficient evidence in support thereof, the Office Action has not met the basic requirements of a prima facie case as set forth in MPEP 2143, and therefore, the combination is improper. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (MPEP 2143.01 citing *In re Mills*). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings (MPEP 2143). The Office Action has instead used impermissible hindsight reconstruction. Indeed, it is only Applicant's application which suggests the desirability of the subject matter recited in the claims. Consequently, the Office Action has not met the basic requirements of a prima facie case as set forth in MPEP 2143, and the combination is therefore improper.

As set forth below, the proposed combination is also improper for failing to meet the requirements of MPEP 2141.02, which states that the prior art must be considered in its entirety, including disclosures that would lead away from the claimed invention (MPEP, Rev. 2, May 2004, page 2100-127, col. 1, lines 3-10 citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert denied, 469 U.S. 851 (1984)).

The proposed combination is also improper for failing to meet the requirements of MPEP 2145 which states that it is improper to combine references where the references teach away from their combination (MPEP 2145, Rev. 2, May 2004, page 2100-162, col. 1, lines 24-30, citing *In re Grasselli* 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

The proposed combination is also improper for failing to meet the requirements of 2143.01, which states that the proposed modification cannot render the prior art unsatisfactory for its intended purpose (MPEP, Rev. 2, May 2004, page 2100-131, col. 2, lines 29-37 citing *in re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

The proposed combination is also improper for failing to meet the requirements of MPEP 2143.01 which states that the proposed modification cannot change the principle of operation of a reference (MPEP, Rev. 2, May 2004, page 2100-132, col. 1, lines 28-37 citing *in re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

DeSimone teach a form of demand caching in which a cache retrieves an object requested by a user and caches the object for later access by other users (col. 1, lines 30-46). DeSimone discloses that caches may have different objects stored thereon that might at some time be requested by a client connected to a cache other than the cache on which the object is stored (abstract, lines 3-6). If caches communicate with each other, the objects stored in one cache could be used to serve clients attached to another cache (col. 1, lines 58-61). Thus, for example, a cache receiving a request for an object may explicitly query other caches at the time when the request for a particular object is made (col. 1, lines 62-66). However determining if an object is on a neighboring cache can impart an unacceptable delay to the user (col. 2, lines 4-10). Furthermore, the flooding of requests to all neighboring caches in response to each request for an object can be wasteful of network bandwidth as well as draining of the caches computing resources (col. 2, lines 10-13). Moreover, a copy of an object as it exists on a neighboring cache may differ from the object as it then exists in the server from which it originated, and thus may not be suitable to be supplied to a client requesting that object.

To overcome the above drawbacks, DeSimone et al. discloses a protocol in which information about the contents of the neighbor caches is exchanged between caches so that when a request for an object is received, the object can be retrieved from the cache in which it is stored (abstract, lines 10-13). This is done asynchronously with respect to user requests so that caches know ahead of time what other caches carry. The delay perceived by the user is therefore reduced (col. 4, lines 59-60).

DeSimone emphasizes that the protocol by which caches update each other about what objects are in their cache is different from actually sending the objects themselves (col. 3, lines 19-23). Indeed DeSimone specifically teaches away from distributing objects themselves:

**[t]he motivation of the present invention for simply sending notification messages instead of the Web objects themselves** is twofold. Firstly, it enables a sense of cache coherency even if the RQC may not have space left on its system to copy the Web object itself. Since this is done asynchronous to user requests, and not as a consequence to a request, caches know ahead of time what other caches carry, and therefore can save delay as perceived by the user (by preventing fruitless queries to neighbor caches), as well as network and cache resources. Secondly, the invention permits a logical separation between information regarding the modification time of an object, and the content of the object itself. **A cache can therefore choose what objects it would like to refresh or cache, before it downloads them.** Since the information carried can include other aspects of the object, such as the size in bytes, the cache is better prepared before downloading the object. For example, the size of a particular object may be very large and the cache may choose not to download it due to insufficient storage capacity.

(DeSimone, col. 4, line 53-col. 5, line 4) (emphasis added)

Armbruster discloses a system for push caching (col. 2, line 50-51), wherein a content provider determines what files are to be cached (col. 4, lines 39-40) and where the files are to be cached (col. 5, lines 7-9). The system includes a content provider 12, a central cache complex 1, local caches, e.g., local cache 10, and routers, e.g., router 17 (col. 3, line 47-col. 4, line 10). The content provider 12 determines what files are to be cached (col. 4, lines 39-40) and thereafter uploads such files to the central complex 1 (col. 4, line 65). A daemon associated with the uplink 5 is alerted that files have been sent and broadcasts them to the local caches (e.g., local cache 10) via a satellite transponder 6 (col. 5, lines 3-5). The content provider decides where the

files are distributed (col. 5, lines 6-7). Software is provided to enable the local cache to save or discard the incoming material, after reception (col. 5, lines 22-23).

As stated above, the combination proposed by the Office Action does not meet the requirements of MPEP 2141.02, which states that the prior art must be considered in its entirety, including disclosures that would lead away from the claimed invention. As stated above, DeSimone emphasizes that the protocol by which caches update each other about what objects are in their cache is different from actually sending the objects themselves (col. 3, lines 19-23). Moreover, DeSimone explicitly teaches away from distributing objects themselves:

**[t]he motivation of the present invention for simply sending notification messages instead of the Web objects themselves** is twofold. Firstly, it enables a sense of cache coherency even if the RQC may not have space left on its system to copy the Web object itself. Since this is done asynchronous to user requests, and not as a consequence to a request, caches know ahead of time what other caches carry, and therefore can save delay as perceived by the user (by preventing fruitless queries to neighbor caches), as well as network and cache resources. Secondly, the invention permits a logical separation between information regarding the modification time of an object, and the content of the object itself. **A cache can therefore choose what objects it would like to refresh or cache, before it downloads them.** Since the information carried can include other aspects of the object, such as the size in bytes, the cache is better prepared before downloading the object. For example, the size of a particular object may be very large and the cache may choose not to download it due to insufficient storage capacity.

(DeSimone, col. 4, line 53-col. 5, line 4) (emphasis added)

Thus, DeSimone teaches away from distributing information as in Armbruster. Consequently, the proposed combination fails to meet the requirements of MPEP 2141.02, which states that the prior art must be considered in its entirety, including disclosures that would lead away from the claimed invention.

Armbruster et al. also teach away from the proposed combination. Armbruster et al. explicitly teach away from demand caching in view of the problems it creates (col. 1, lines 26-55; col. 2, lines 3-4). According to Armbruster, demand caching and its hierarchies make routing difficult and are complex to maintain and implement (col. 1, lines 50-52). In addition, demand caching often violates copyright laws (col. 1, lines 46-47). Moreover, with demand

caching, clients determine what is cached by their access patterns (col. 1, lines 36-37). As a result, the content provider becomes a passive participant and is often unaware that its material is being copied and stored (col. 1, lines 43-46). This makes it difficult for content providers to control access to their sites and to get an accurate picture of how often their pages are being accessed (col. 1, lines 53-56). Still further, with demand caching, cached copies and originals are not synchronized, and as a result, the copy returned to other users is sometimes not the content providers most recent copy but rather the previously cached version. Modifying DeSimone to distribute objects as proposed by the Office Action would only serve to magnify and exacerbate such problems.

DeSimone and Armbruster thus each teach away from the combination proposed by the Office Action.

Thus, the proposed combination is improper for failing to meet the requirements of MPEP 2141.02, which states that the prior art must be considered in its entirety, including disclosures that would lead away from the claimed invention (MPEP, Rev. 2, May 2004, page 2100-127, col. 1, lines 3-10 citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert denied, 469 U.S. 851 (1984))).

The proposed combination is also improper for failing to meet the requirements of MPEP 2145 which states that it is improper to combine references where the references teach away from their combination (MPEP 2145, Rev. 2, May 2004, page 2100-162, col. 1, lines 24-30, citing *In re Grasselli* 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

Nor does the combination proposed by the Office Action meet the requirements of MPEP 2141.01, which states that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. **DeSimone** explicitly states that the system **allows a cache to choose what objects it would like to refresh or cache, before it downloads them** (col. 4, lines 65-66). In contrast thereto, **Armbruster does not allow the receiving caches to decide whether to save or discard a file until after reception of the file** (col. 5, lines 22-24). Modifying the system of DeSimone to distribute information as in Armbruster would thus leave the system without the ability to allow a cache to choose what objects it would like to refresh or cache, before it downloads them, thereby leaving the system unsatisfactory for its intended purpose. The proposed combination therefore flatly ignores an intended purposes of the system of DeSimone and fails to meet the requirements of MPEP 2141.01, which states that the proposed modification cannot render the prior art unsatisfactory for its intended purpose. One of ordinary skill in the art

would not modify DeSimone to distribute information as taught in Armbruster if the modification would leave the system unsatisfactory for its intended purpose.

The proposed combination is thus also improper for failing to meet the requirements of 2143.01, which states that the proposed modification cannot render the prior art unsatisfactory for its intended purpose (MPEP, Rev. 2, May 2004, page 2100-131, col. 2, lines 29-37 citing in re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

In addition, in view thereof, the proposed combination is also improper for failing to meet the requirements of MPEP 2143.01 which states that the proposed modification cannot change the principle of operation of a reference (MPEP, Rev. 2, May 2004, page 2100-132, col. 1, lines 28-37 citing in re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Applicant has thus presented clear evidence that the references in fact teach away from the proposed combination and that the proposed combination would leave the system unsatisfactory for its intended purpose. Consequently, the Office Action has not met the requirements of a prima facie case as set forth in MPEP 2143 and the combination is therefore improper.

Accordingly, reconsideration of the rejection of claim 1 is respectfully requested.

Claims 2-13 depend from claim 1. For at least the reasons set forth above, reconsideration of the rejection of claims 2-13 is respectfully requested.

#### **CLAIMS 14-26**

Paragraphs 9 and 22 of the Office Action reject claim 14 under 35 U.S.C. §103(a) as being unpatentable over DeSimone in view of Armbruster.

As stated above, the proposed combination of DeSimone and Armbruster is improper.

Accordingly, reconsideration of the rejection of claim 14 is respectfully requested.

Claims 15-26 depend from claim 14. For at least the reasons set forth above, reconsideration of the rejection of claims 15-26 is respectfully requested.

#### **CLAIMS 27-34**

Paragraphs 9 and 35 of the Office Action reject claim 27 under 35 U.S.C. §103(a) as being unpatentable over DeSimone in view of Armbruster.

As stated above, the proposed combination of DeSimone and Armbruster is improper.

Accordingly, reconsideration of the rejection of claim 27 is respectfully requested.

Claims 28-34 depend from claim 27. For at least the reasons set forth above, reconsideration of the rejection of claims 28-34 is respectfully requested.

#### **CLAIMS 35-42**

Paragraphs 9 and 43 of the Office Action rejects claim 35 under 35 U.S.C. §103(a) as being unpatentable over DeSimone in view of Armbruster.

As stated above, the proposed combination of DeSimone and Armbruster is improper.

Accordingly, reconsideration of the rejection of claim 35 is respectfully requested.

Claims 36-42 depend from claim 35. For at least the reasons set forth above, reconsideration of the rejection of claims 36-42 is respectfully requested.

#### **CLAIM 43**

Paragraphs 9 and 43 of the Office Action reject claim 43 under 35 U.S.C. §103(a) as being unpatentable over DeSimone in view of Armbruster.

As stated above, the proposed combination of DeSimone and Armbruster is improper.

Accordingly, reconsideration of the rejection of claim 43 is respectfully requested.

#### **CONCLUSION**

Reconsideration of all of the pending claims is hereby respectfully requested.

Because the reasons above are sufficient to traverse the rejections, Applicant has not presented other possible reasons for traversing such rejections. Nonetheless, Applicants expressly reserve the right to do so, if appropriate, in response to any future response and/or proceeding. For example, additional reasons for traversing the rejections were presented in the prior response. In addition, because the rejections of the independent claims are improper, Applicant has not explored nor presented additional reasons for traversing the rejections of the dependent claims. Nonetheless, Applicants expressly reserve the right to do so, if appropriate, in response to any future response and/or proceeding. Accordingly, Applicant should not be deemed to have admitted the accuracy of any assertions made in the Office Action and not specifically addressed herein.

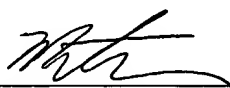
If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee



occasioned by this response, including an extension fee that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50-1402.

Respectfully submitted,

Date: September 20, 2004

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